

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Pamela McKissick et al.  
Application No. : 09/378,533 Confirmation No. : 9255  
Filed : August 20, 1999  
For : ELECTRONIC PROGRAM GUIDE WITH ADVANCE  
NOTIFICATION  
Group Art Unit : 2424  
Examiner : Son P. Huynh

New York, New York 10036  
May 29, 2009

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

PETITION UNDER 37 C.F.R. § 1.181(a)  
TO WITHDRAW HOLDING OF ABANDONMENT

Sir:

In response to the Notice of Abandonment mailed March 30, 2009 by the United States Patent and Trademark Office ("USPTO"), applicants hereby petition under 37 C.F.R. § 1.181(a) to withdraw the holding of Abandonment set forth in the Notice of Abandonment (copy attached as Exhibit A). Pursuant to 37 C.F.R. § 1.181(f) and MPEP § 711.03(c)(I)(C), this Petition is being timely filed within two months of the mailing date of the Notice of Abandonment (i.e., on or before May 30, 2009).

## Introduction

On January 28, 2008, an Office Action was mailed by the USPTO (copy attached as Exhibit B.)

On June 27, 2008, applicants filed a Pre-Appeal Request for Review (copy attached as Exhibit C) and a Notice of Appeal (copy attached as Exhibit D) in response to the Office Action. The listing of the documents located in the image file wrapper on Private PAIR for this application indicates that the Notice of Appeal was received by the USPTO on June 27, 2008.

On December 8, 2008, the USPTO mailed a Notice of Panel Decision from Pre-Appeal Brief Review ("Notice of Panel Decision"). (A copy of the Notice of Panel Decision is attached as Exhibit E.)

On March 30, 2009, the USPTO mailed a Notice of Abandonment alleging that applicants had failed to timely file a proper reply to the Office letter mailed December 8, 2008.

## Petition under 37 C.F.R. § 1.181(a) to Withdraw Holding of Abandonment

The Notice of Panel Decision states that "the time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable."

Applicants respectfully submit that the one month date from the mailing of the Notice of Panel Decision is January 8, 2009 while the two-month date from the receipt of the notice of appeal is August 27, 2008. Accordingly, upon receipt of the Notice of Panel Decision, the time period for filing an appeal brief was reset to be January 8, 2009 (i.e., the greater of the two dates).

Moreover, since the time period for filing the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of the decision on the request, applicants respectfully submit that an appeal brief could be timely filed within six months of the mail date of the decision on the request (i.e., on or before June 8, 2009). Applicants therefore submit that

the abandonment set forth in the Notice of Abandonment was improper at least because the Notice of Abandonment, which was mailed on March 30, 2009, was mailed during the period within which an appeal brief could be timely filed (i.e., on or before June 8, 2009). Accordingly, applicants hereby petition under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment set forth in the Notice of Abandonment.

### Conclusion

Based on the foregoing, applicants respectfully request that the USPTO grant this Petition to withdraw the holding of abandonment, and enter the reply to Office Action filed herewith in the above-identified patent application. Pursuant to MPEP § 711.03(c)(I)(B), no fee is due in connection with this Petition. Should any fees be due, however, the Director is hereby authorized to charge any fee that may be due in connection with this Petition to Deposit Account 06-1075 (Order No. 003597-0098).

Respectfully submitted,

/Baaba Andam/

---

Baaba Andam  
Limited Recognition No. L0455  
Agent for Applicants  
Ropes & Gray LLP  
Customer No. 75563

# EXHIBIT A



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/378,533

08/20/1999

PAMELA L. MCKISSICK

UV-98

9255

75563

7590

03/30/2009

ROPES & GRAY LLP

PATENT DOCKETING 39/361

1211 AVENUE OF THE AMERICAS

NEW YORK, NY 10036-8704

**RECEIVED**

**APR 06 2009**

ROPES & GRAY LLP - IP DOCKETING  
REFERRED TO \_\_\_\_\_  
NOTED BY \_\_\_\_\_

EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Notice of Abandonment**

Application No.

09/378,533

Examiner

SON P. HUYNH

Applicant(s)

MCKISSICK ET AL.

Art Unit

2424

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 08 December 2008.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

/Son P Huynh/  
Primary Examiner, Art Unit 2424

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

# EXHIBIT B



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/378,533      | 08/20/1999  | PAMELA L. MCKISSICK  | UV-98               | 9255             |

75563 7590 01/28/2008  
ROPES & GRAY LLP  
PATENT DOCKETING 39/361  
1211 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-8704

**RECEIVED**

FEB 01 2008

ROPES & GRAY LLP, PATENT DOCKETING  
REFERRED TO: Shirley BA  
NOTED BY: BA

EXAMINER

KOENIG, ANDREW Y

ART UNIT PAPER NUMBER

2623

MAIL DATE DELIVERY MODE

01/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

File No.: LIV/098  
Action Desc: Descriptive  
Due Date: Apr 28, 2008  
By: [Signature]

File No.: LIV/098  
Action Desc: Descriptive  
Due Date: Apr 28, 2008  
By: [Signature]



|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/378,533 | <b>Applicant(s)</b><br>MCKISSICK ET AL. |  |
|                              | <b>Examiner</b><br>Andrew Y. Koenig  | <b>Art Unit</b><br>2623                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 63-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 63-86 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 63, 66, 67, 69, 70, 74, 75, 77, 79, 80, 82, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,351,075 to Herz et al. (Herz) in view of U.S. Patent 5,699,107 to Lawler et al. (Lawler).

Regarding claims 63, 69, 77, and 82, Herz teaches a dynamic scheduling system that receives user votes for movies to adjust the prime-time viewing periods (col. 3, ll. 27-53). Herz teaches displaying a list of a plurality of program titles, wherein each of the plurality of program titles is for an unscheduled program that is outside a program listings time frame that is currently available to a user (col. 5, ll. 36-41, col. 5, ll. 60-63). Displaying information with the plurality of program titles, wherein the information informs the user that the unscheduled programs are outside the program listings time frame that is currently available to the user and informs the user that the unscheduled

programs are expected to be available at a later time (lists of includes information derived from video magazines discloses upcoming releases, and date of the release – col. 5, ll. 60-63). Herz teaches providing the user with the opportunity to select a program title from the list of the plurality of program titles (col. 5, ll. 30-50), and providing a notification to the user of the availability of the program-corresponding to the selected program title when the program is now in the program listings time frame (Herz teach referring to a program guide to selectively record their selections – col. 6, ll. 34-35).

Whereas Herz teaches providing program-specific availability notifications to the user in the form of program guides for permitting uses to program their VCRs for later viewing, Herz fails to teach displaying a program specific notification when the program is now in the current program listing time frame. Lawler teaches providing reminder notifications (figs. 8 and 9, col. 12, ll. 44-47, col. 13, ll. 11-15), which read on displaying a program specific notification when the program is now in the current program listing time frame.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz by displaying a program specific notification when the program is now in the current program listing time frame as taught by Lawler in order to provide preferred programming information to viewers prior to the start of the program.

Regarding claims 66, 74, 79, and 84, Herz is silent on providing a message notification. Lawler teaches providing a message notification, as shown in figure 9, col. 12, ll. 44-47, col. 13, ll. 11-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the manual searching of the program guide of Herz by providing a message notification as taught by Lawler in order to automate a process with the added benefit of creating reminders for the user, thereby enhancing the user's ability to view requested programming.

Regarding claims 67, 75, 80, and 85, Herz is silent on providing a reminder notification. Lawler teaches providing a reminder notification, as shown in figure 9, col. 12, ll. 44-47, col. 13, ll. 11-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the manual searching of the program guide of Herz by providing a reminder notification as taught by Lawler in order to automate a process with the added benefit of creating reminders for the user, thereby enhancing the user's ability to view requested programming.

Regarding claim 70, Herz teaches user television equipment (fig. 1, labels 40 and 50).

4. Claims 64, 68, 71, 72, 76, 78, 81, 83, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,351,075 to Herz et al. (Herz) and U.S. Patent 5,699,107 to Lawler et al. (Lawler) in view of U.S. Patent Application Publication 2005/0204388 to Knudson et al. (Knudson).

Regarding claims 64, 72, 78, and 83, Herz is silent on displaying a list of programs for which a notification is to be provided. Knudson teaches displaying a list of programs for which a notification is to be provided (as shown in figure 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz by displaying a list of programs for which a notification is to be provided as taught by Knudson in order to view and manage current reminder within the guide.

Regarding claims 68, 76, 81, and 86, Herz is silent on providing the user with the opportunity to setup a configuration of the notification. Knudson teaches providing the user with the opportunity to setup a configuration of the notification (fig. 7-8, 10a, 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz by providing the user with the opportunity to setup a configuration of the notification as taught by Knudson in order to customize the reminders so that the reminder will appear at a time that the user desires, thereby increasing the flexibility of the system for different users.

Regarding claim 71, Herz is silent on the equipment can be a personal computer. Knudson teaches that the equipment can be a personal computer (pg. 3-4, para. 0047).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz by using a personal computer as taught by Knudson in order to enable different devices to interface with the system, while increasing the functionality of a multipurpose computing device.

5. Claims 65 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,351,075 to Herz et al. (Herz) and U.S. Patent 5,699,107 to Lawler et al. (Lawler) in view of U.S. Patent Publication No. US 2002/0026496 to Boyer et al. (Boyer).

Regarding claims 65 and 73, Herz and Lawler are silent on notifying the user with electronic mail.

Boyer teaches notifying the user with electronic mail; Boyer, in the same field of endeavor, teaches a television programming system with electronic mail notifications of desired programming (page1, paragraph 6, paragraph 9; see also page 4, paragraph 51) for the advantage of delivering notifications of programming selections to any internet accessible system.

One of ordinary skill in the art would recognize the benefit of notifying the user with electronic mail in order to deliver notifications of programming selections to any Internet accessible system

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz and Lawler to notify said user with electronic mail, as taught by Boyer, for the advantage of delivering notifications of programming selections to any Internet accessible system.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Application/Control Number:  
09/378,533  
Art Unit: 2623

Page 8

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Andrew Y Koenig  
Primary Examiner  
Art Unit 2623

ayk



# EXHIBIT C

PATENTS  
UV-98

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:  
McKissick, et al.

Application No.: 09/378,533

Confirmation No.: 9255

Filed: August 20, 1999

Art Unit: 2623

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For: ELECTRONIC PROGRAM GUIDE WITH  
ADVANCE NOTIFICATION

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Examiner: Koenig, Andrew Y.

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

New York, New York 10036  
June 27, 2008

PRE-APPEAL REQUEST FOR REVIEW

Sir:

In response to the final Office Action pending in the above referenced application, Applicants request a panel review of the pending rejections prior to proceeding with the full appeals process. Applicants enclose the requisite Notice of Appeal along with the remarks set forth below.

The application includes 24 claims, four of which (claims 63, 69, 77, and 82) are independent. Claims 63, 66, 67, 69, 70, 74, 75, 77, 79, 80, 82, 84, and 85 stand rejected under 35 U.S.C. 103(a) over the combination of Herz et al. U.S. Patent No. 5,351,075 and Lawler et al. U.S. Patent No. 5,699,107. Claims 64, 68, 71, 72, 76, 78, 81, 83, and 86 stand rejected under 35 U.S.C. § 103(a) over the combination of Herz, Lawler, and Knudson et al. U.S. Patent Application No. 2005/0204388. Claims 65 and 73 stand rejected under 35 U.S.C. § 103(a) over the combination of Herz, Lawler, and Boyer et al. U.S. Patent Application No. 2002/0026496. Applicants respectfully disagree and assert that the above rejections are based on clear errors.

Arguments begin on page 2 of this paper.

I. Because Lawler does not teach or suggest "providing a program-specific availability notification to the user indicating the availability of the program corresponding to the selected program title when the corresponding program is now in the current program listings time frame," the § 103 Rejection of base claims 63, 69, 77, and 82 is based on clear error and should be withdrawn

The Examiner admits that Herz does not provide "a program-specific availability notification to the user indicating the availability of the program corresponding to the selected program title when the corresponding program is now in the current program listings time frame." The Examiner tries to make up for this deficiency using Lawler. See Office Action, page 3.

Lawler, however, discloses providing a program reminder which only indicates that a program is about to begin. For example, Lawler states that, "Once a reminder for a particular program is set, the system monitors the reminder and, shortly before the program is available, informs the user that the program is about to begin." See col. 12, lines 34-37. In contrast, the program-specific availability notification, as recited in base claims 63, 69, 77, and 82, informs the user that a program that was previously outside a program listings time frame is now in the current program listings time frame. More particularly, base claims 63, 69, 77, and 82 recite providing or displaying "a program-specific availability notification to the user indicating the availability of the program corresponding to the selected program title when the corresponding program is now in the current program listings time frame." For example, FIG. 2 of the present invention provides an example of an advertisement 76, e.g., "Blair Witch Project Coming to PPV," for a program that is outside a program listing time frame. When the "Blair Witch Project" program is eventually included in a current program listings time frame, a program-specific availability notification is provided to a user. This type of notification is clearly very different than the program reminder provided by Lawler.

Thus, even if Herz and Lawler were combinable, which applicant disputes, the resulting combination would not be the invention as recited in applicant's base claims 63, 69, 77, and 82. Accordingly, the Examiner has failed to make a prima facie case of obviousness for base claims 63, 69, 77, and 82 and the §103 Rejection of base claims 63, 69, 77, and 82 should be withdrawn.

II. The §103 Rejection of claims 64, 66-68, 70-72, 74-76, 78-81, and 83-86 is based on clear errors and should be withdrawn

Based on the discussion above, applicants' base claims 63, 69, 77, and 82 are allowable. Applicants respectfully submit that Knudson and Boyer do not make up for the deficiencies in Herz and Lawler. Thus, claims 64, 66-68, 70-72, 74-76, 78-81, and 83-86 which depend from, and are limited by base claims 63, 69, 77, and 82 respectively are also allowable. The §103 Rejection of claims 64, 66-68, 70-72, 74-76, 78-81, and 83-86 should therefore be withdrawn.

Applicants believe no fee is due with this response other than as reflected on the enclosed Petition for Extension of Time Transmittal. However, if a fee is due, please charge our Deposit Account No. 06-1075 from which the undersigned is authorized to draw.

Respectfully submitted,

/Baaba Andam/

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Baaba Andam  
Limited Recognition No. L0455  
Agent for Applicants  
Ropes & Gray LLP  
Customer No. 75563  
1211 Avenue of the Americas  
New York, New York 10036-8704  
Tel.: (212) 596-9000

# EXHIBIT D

**NOTICE OF APPEAL FROM THE EXAMINER TO  
THE BOARD OF PATENT APPEALS AND INTERFERENCES**Docket Number (Optional)  
UV-98

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_In re Application of  
McKissick et al.Application Number  
09/378,533Filed  
August 20, 1999For ELECTRONIC PROGRAM GUIDE WITH  
ADVANCE NOTIFICATIONArt Unit  
2623Examiner  
Andrew Y. KoenigApplicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20 (b)(1))

\$510.00

- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ \_\_\_\_\_
- ☐ A check in the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 06-1075, Order No. 003597-0098. I have enclosed a duplicate copy of this sheet.
- ☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☐ attorney or agent of record.

Registration number \_\_\_\_\_

/Baaba Andam/

Signature

Baaba Andam

Typed or printed name

(212) 596-9000

Telephone number

- ☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. \_\_\_\_\_

Limited Recognition  
No. L0455

June 27, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

- ☒ \*Total of 1 forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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# EXHIBIT E



# UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/378,533      | 08/20/1999  | PAMELA L. MCKISSICK  | UV-98               | 9255             |

75563 7590 12/08/2008  
ROPES & GRAY LLP  
PATENT DOCKETING 39/361  
1211 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-8704

**RECEIVED**

**DEC 12 2008**

ROPES & GRAY LLP - IP DOCKETING  
REFERRED TO \_\_\_\_\_  
NOTED BY \_\_\_\_\_

|          |
|----------|
| EXAMINER |
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HUYNH, SON P

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2424

|           |               |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

12/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



|  |                         |  |  |
|--|-------------------------|--|--|
| <b>Notice of Panel Decision<br/>from Pre-Appeal Brief<br/>Review</b> | Application/Control No. | Applicant(s)/Patent under<br>Reexamination |  |
|  | 09/378,533              | MCKISSICK ET AL.                           |  |
|  | CHRISTOPHER KELLEY      | Art Unit<br>2424                           |  |
|  |                         |  |  |

This is in response to the Pre-Appeal Brief Request for Review filed 27 June 2008.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 63-86.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) CHRISTOPHER KELLEY.

(3) Andrew Koenig.

(2) Son Huynh.

(4) \_\_\_\_\_.

/Chris Kelley/  
Supervisory Patent Examiner, Art  
Unit 2424

/Andrew Y Koenig/  
Supervisory Patent Examiner, Art  
Unit 2423